

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KAREN A. SHEPPARD,  
JAY K. KEUNG, FRANCIS T. THE-DZUY,  
JOSEPH E. BREW, and BENOIT AMBROISE

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Appeal No. 96-2710  
Application 08/164,598<sup>1</sup>

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HEARD: May 6, 1999

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Before KIMLIN, WARREN, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 of claims 1, 4,  
6 through 15, and 17 through 20, which are all of the claims

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<sup>1</sup> Application for patent filed December 9, 1993.

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remaining in the application. Although the examiner's advisory action indicated that upon filing an appeal, "the proposed amendment will be entered," (see the advisory action dated 08/10/95, Paper No. 10), appellants' response under 37 CFR

§ 1.116 dated 07/31/95, Paper No. 9, did not contain any amendments to the claims.

#### THE INVENTION

Appellants' invention is directed to a film structure comprising at least one layer of an olefin polymer having a surface treated external layer which is printable, sealable and machinable. The layer contains as combined slip agent and antiblock, a particulate crosslinked hydrocarbyl substituted polysiloxane. The external surface comprises a liquid hydrocarbyl substituted polysiloxane.

#### THE CLAIMS

Claim 1 is illustrative of appellants' invention and is reproduced below.

1. A film structure comprising at least one layer of an olefin homo-, co- or ter-polymer having a surface-treated external surface which is printable, sealable and machinable, the layer containing, as combined slip agent and antiblock, a particulate cross-linked hydrocarbyl-substituted polysiloxane,

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the external surface comprising a liquid hydrocarbyl-substituted polysiloxane.

#### THE REFERENCES OF RECORD

As evidence of obviousness, the examiner relies upon the following references:

Balloni et al. [Balloni ('992)]	4,961,992	Oct. 9, 1990
Kawakami et al. [Kawakami]	4,966,933	Oct. 30, 1990
Balloni et al. [Balloni ('671)]	5,110,671	May 5, 1992

#### THE REJECTIONS

Claims 1, 4, 6 through 13, 15, and 17 through 20 stand rejected under 35 U.S.C. § 103 as unpatentable over Kawakami in view of Balloni ('671).

Claim 14 stand rejected under 35 U.S.C. § 103 as unpatentable over Kawakami in view of Balloni ('671) and Balloni ('992).

#### OPINION

Appellants submit that claim 14 now on appeal does not stand or fall together with the other claims. Brief, page 6.

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Appellants, however, have not argued the separate patentability of the balance of the claims. Accordingly, we will treat the balance of the claims as standing or falling together. We select claim 1 as representative of appellants' claimed subject matter and limit our consideration to claims 1 and 14. 37 CFR § 1.192(c)(7)(1995).

We have carefully considered appellants' arguments for patentability. However, we are essentially in complete agreement with the examiner that the claimed subject matter is unpatentable in view of the applied prior art. Accordingly, we will sustain the examiner's rejections for essentially those reasons expressed in the Answer, and we add the following primarily for emphasis.

The sole issue before us is whether the examiner has established a prima facie case of obviousness based upon the rejection of record. Appellants argue that, "[t]he propylene polymer film containing crosslinked silicone resin and hydroxy-fatty acid glyceride, both for improved slipperiness, as disclosed in the primary reference of Kawakami, is not

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properly combinable with the secondary references." See Brief, page 7. We disagree.

An analysis of the primary reference to Kawakami requires us to conclude that the patent contemplates the presence of multiple slip agents provided only that they are not detrimental to the objects of the invention. Both the crosslinked silicone resin and the hydroxy-fatty acid glyceride are present in Kawakami in part to provide slipperiness. See column 2, line 64 through column 3, line 15. As stated therein, if the amount of either compound falls below a requisite minimum the slipperiness is not satisfactory. Nor does Kawakami contemplate that these be the only slipperiness agents present in the invention. In column 4, lines 22-40, Kawakami suggests that additional "slip agents" may be added to the olefin polymer film of his invention. Moreover, patentee specifically provides that, "known ....slip agents.... can be incorporated in the composition constituting the propylene polymer film of the present invention in amounts not hindering the attainment of the objects of the present invention." We conclude that Kawakami would have suggested the addition of any number of

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slip agents, although the specific liquid hydrocarbyl substituted polysiloxane is not specifically suggested.

While Kawakami does not specifically disclose the specific silicone oil slip agent of the claimed subject matter, Balloni('671) teaches a polypropylene polymer packaging film, having a coating of silicone oil on the film to lower the coefficient of friction and provide hot slip properties. Our analysis is in agreement with the examiner's. The examiner has correctly pointed out that the addition of the claimed silicone oil slip agent into the polypropylene packaging film of Balloni results in improved running properties and heat seal characteristics. Accordingly, we concur with the examiner that it would have been *prima facie* obvious for one of ordinary skill in the art to select the silicone oil taught by Balloni('671) as a suitable slip agent in the propylene polymer packaging film composition of Kawakami.

It is well settled that it is a matter of obviousness for one of ordinary skill in the art to combine two or more materials when each is taught by the prior art to be useful for the same purpose. In re Kerkhoven, 626 F.2d 846, 850, 205

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USPQ 1069, 1072 (CCPA 1980). Here, appellants have simply combined materials known to be slip control agents for propylene polymer films.

We further conclude that the prior art would have suggested to those of ordinary skill in the art that they should make the claimed subject matter and has revealed that in so making or carrying out, those of ordinary skill in the art would have had a reasonable expectation of success. See In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

We next turn to consideration of the rejection of claim 14 which additionally requires flame treating an outer surface of the film structure. We agree with and incorporate the examiner's rejection as set forth in the Answer, page 5. We add only the following brief comment for emphasis.

Balloni('671), in Example 3, likewise, uses a flame treatment to produce a desirable surface effect on the film. Hence, Balloni ('992) is needed only for its teaching of improved ink receptivity as a result of the flame treatment. See Balloni('992), column 3, lines 35-37. We conclude that it was reasonable for the examiner to rely on the teachings of both

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Balloni references to show the advantages of flame treating polypropylene polymer film. Accordingly, it would have been obvious to one of ordinary skill in the art to prepare appellants' claimed film structure by incorporating the silicone oil of Balloni to achieve improved slip characteristics and utilize the flame treatment of both Balloni patents to improve printability. We note that appellants have presented no arguments based upon objective evidence of non-obviousness that would serve to rebut the *prima facie* case of obviousness.

#### DECISION

The rejection of claims 1, 4, 6 through 13, 15, and 17 through 20 under 35 U.S.C. § 103 as unpatentable over Kawakami in view of Balloni('671) is affirmed.

The rejection of claim 14 under 35 U.S.C. § 103 as unpatentable over Kawakami in view of Balloni('671) and Balloni ('992) is affirmed.

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).



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AFFIRMED

	Edward C. Kimlin	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Charles F. Warren	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
	Paul Lieberman	)	
	Administrative Patent Judge	)	

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